

REMARKS/ARGUMENTS

1.) Claim Amendments

Claims 2-5, 7-13, 16, 17, 20, and 21 are pending in the application. The Applicants have amended claims 5 and 9-13. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections – 35 U.S.C. § 112

On Page 2 of the Office Action, the Examiner rejected claims 11 and 13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant has amended claims 11 and 13 to provide proper antecedent basis for the limitations noted by the Examiner. Therefore, withdrawal of the § 112 rejection is respectfully requested.

3.) Claim Rejections – 35 U.S.C. § 103(a)

On Page 3 of the Office Action, the Examiner rejected claims 2-5 and 7-13 under 35 U.S.C. § 103(a) as being unpatentable over Lindgren et al. (US 2002/0002041) in view of Soininen et al. (US 2004/0252674). The Applicants have amended the claims to better distinguish the claimed invention from Lindgren and Soininen. The Examiner's consideration of the amended claims is respectfully requested.

Lindgren describes a process by which one portion or leg of a call connection is set up as a packet-switched session and another portion or leg of the call connection is set up as a circuit-switched connection. (See Figs. 1 & 4 as cited by the Examiner).

The Applicants' claimed invention is different because it claims a process by which a packet-switched session is set up from end-to-end between two user terminals (see Figs. 2 & 4, non-conversational bearer), and then a circuit-switched conversational bearer is also set up between the two user terminals in parallel with the packet-switched session.

The Applicants have amended independent claim 5 to delete the confusing and unnecessary statement in the preamble, "said session extending at least in part across a circuit switched access network." In the claimed invention, the parallel circuit-switched connection is set up through a circuit-switched access network, but the packet-switched session is established between the peer user terminals via an IP-based packet-switched access network, as recited in the first step of claim 5.

Soininen discloses setting up a packet-switched session in parallel with a circuit-switched connection, but the control functionality is resident within the user terminals, not the network. There is no suggestion whatsoever of any network-resident functionality for setting up a packet-switched session in parallel with a circuit-switched connection.

The Applicants' claimed invention, on the other hand, includes functionality in a SIP server in an IMS network for setting up a packet-switched session in parallel with a circuit-switched connection. There is no suggestion whatsoever of any network-resident functionality for setting up a packet-switched session in parallel with a circuit-switched connection in Lindgren or Soininen. Therefore, the withdrawal of the § 103 rejection and the allowance of amended claim 5 and dependent claims 2-4 and 7-13 are respectfully requested.

3.) Claim Rejections – 35 U.S.C. § 102(b)

On Page 8 of the Office Action, the Examiner rejected claims 16, 17, 20, and 21 under 35 U.S.C. § 102(b) as being anticipated by Lindgren. The Applicants respectfully disagree.

As noted above, Lindgren describes a process by which one portion or leg of a call connection is set up as a packet-switched session and another portion or leg of the call connection is set up as a circuit-switched connection. There is no teaching or suggestion in Lindgren of setting up a circuit-switched connection in parallel with a packet-switched session.

Regarding claim 16, the last element of the claim reads, "means for causing the at least one conversational bearer to be set up *in parallel* with the packet switched

session." (emphasis added). Therefore, the allowance of claim 16 is respectfully requested.

Regarding claim 17, the last element of the claims reads, "means for setting up the circuit switched call *in parallel* with a packet switched session." (emphasis added). Therefore, the allowance of claim 16 is respectfully requested.

Claims 20 and 21 depend from base claims 16 and 17, respectively, and recite further limitations in combination with the novel elements of claims 16 and 17. Therefore, the allowance of claims 20 and 21 is respectfully requested.

5.) Prior Art Not Relied Upon

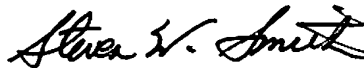
On Page 10 of the Office Action, the Examiner stated that the prior art made of record and not relied upon is considered pertinent to the Applicants' disclosure. However, the Applicants' review of these references has not revealed any teaching or suggestion of network elements that set up a packet-switched session in parallel with a circuit-switched connection.

6.) Conclusion

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 2-5, 7-13, 16, 17, 20, and 21.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would expedite the prosecution of the Application.

Respectfully submitted,



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